

## REMARKS

### Claim rejections under 35 USC 101

Claims 33-39 have been rejected under 35 USC 101 because independent claims 33 and 35 can encompass non-statutory subject matter, such as carrier waves. Applicant has amended independent claims 33 and 35 so that they particularly recite a “storage device.” It is noted that the specification on page 2, lines 19-24, states that “the functions described herein are implemented in software in one embodiment, where the software comprises computer executable instructions stored on computer-readable media *such as memory or other types of storage devices.*” Memory, and other types of storage devices, are tangible, in contradistinction to carrier waves, which are not. Therefore, insofar as independent claims 33 and 35 particularly recite a storage device, they are statutory under 35 USC 101. The other claims rejected on this basis are statutory due to their dependence from a statutory independent claim.

### Claim rejections under 35 USC 103

Claims 1-2, 4-8, 10-11, and 19-39 have been rejected under 35 USC 103(a) as being unpatentable over Botham (6,785,812), in view of Ginter (6,185,683), and further in view of Holloway (5,912,974). Claims 3, 9, and 12-18 were previously cancelled, and Applicant has without prejudice cancelled claims 23-32 in the present response. Claims 1, 19, 33, and 35 are independent claims, from which the remaining pending claims ultimately depend. Applicant submits that the independent claims are patentable over Botham in view of Ginter and further in view of Holloway, such that the remaining pending claims are patentable at least because they each depend from a patentable base independent claim.

Applicant discusses claim 1 herein as representative of all the independent claims 1, 19, 33, and 35 insofar as the present rejection is concerned. Applicant notes that claim 1 has not been

amended in this response. However, claims 19, 33, and 35 have been amended to introduce limitations consistent with those already present in claim 1.

As to the representative independent claim 1, Applicant focuses on one limitation of claim 1 that is not taught, disclosed, or suggested by Botham in view of Ginter and further in view of Holloway. This limitation is that “the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document.” Applicant notes that all the claim limitations of claim 1 have to be considered in assessing the patentability of this claim over the prior art. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970))

More specifically, Applicant notes that claim 1 is limited to “destroying the original document *at the system of the sender* after transmitting the image of the original document to the system of recipient, *where the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document.*” Note the explicit ordering of these two actions. Claim 1 is specifically and particularly limited to destruction of the original document at the system of the sender only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document. That is, the action of destroying the original document at the system of the sender is explicitly tied in order of performance to the action of the system of the sender receiving assurance that the system of the recipient has received transmission of the image of the original document.

Applicant submits that neither Botham, Ginter, or Holloway teach, disclose, or suggest the limitation that “the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document,” such that Botham in combination with Ginter and Holloway cannot be considered as teaching, disclosing, or suggesting all the claim limitations

of claim 1. As to Holloway, this reference has been introduced by the Examiner only to disclose the notary public-related limitations of claim 1. Applicant has also reviewed Holloway as to the limitation that “the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document,” however, and notes that Holloway indeed does not teach, disclose, or suggest this limitation as well.

As to Ginter, the Examiner has stated that Ginter teaches, discloses, or suggests that “the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document” in column 8, lines 12-14. However, this excerpt of Ginter only states that “[o]riginal’ item(s) can automatically be destroyed at the sender’s end and reconstituted at the recipient’s end *to prevent two originals from existing simultaneously.*” (Emphasis added) Applicant submits that Ginter in this excerpt, as well as in any other portion of the reference, does not actually rise to the level of teaching, disclosing, or suggesting that “the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document,” in contradistinction to the claimed invention, as is now discussed in detail.

Consider the following table diagrammatically illustrating the limitations of claim 1:

Time	Sender	Receiver	Where document exists
t0	Send document to receiver		Sender only
t1		Receive document from sender	Sender and receiver
t2	Receive assurance that recipient has received document		Sender and receiver
t3	Destroy document		Receiver only

Thus, in claim 1, at time t0 the sender sends the document to the receiver (i.e., “transmits an image of the original document to the system of the recipient”). Therefore, of course, the receiver

receives the document from the sender, at time t1. Thereafter, at time t2, the sender receives assurance that the recipient has received the document (i.e., “the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document”). Only once the sender has received assurance that the recipient has received the document does the sender destroy the document, at time t3 (i.e., “the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document”).

Importantly and significantly, then, as illustrated in the table above, the document exists at both the sender and the receiver from time t1 until time t3. That is, until the sender has received assurance that the recipient has in fact received the document, the sender does not destroy the document at its end. This is in direct contradiction to Ginter, in which “original items can automatically be destroyed at the sender’s end and reconstituted at the recipient’s end to prevent two originals from existing simultaneously.” In the claimed invention, you necessarily have two originals existing simultaneously – the copy at the sender’s end at the copy at the receiver’s end – until the sender has received assurance that the receiver has in fact received the document. The document is not destroyed “automatically,” as in Ginter, but rather is destroyed only after the sender has received assurance that the receiver has in fact received the document. Ginter, and thus Botham in view of Ginter and Holloway, teach, disclose, and suggest that the document is not to exist simultaneously at both the sender’s end and at both the receiver’s end, unlike as in the claimed invention. Therefore, it cannot be said that Ginter in particular teaches the limitation of claim 1.

Finally, as to Botham, the Examiner has indicated that Botham also discloses teaches, discloses, or suggests that “the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document,” in column 4, lines 9-10 and 34-35. However, this excerpt of Botham only states the following:

Permissions 121 specify what receiving client 101 is entitled to do with document 120. For example, they specify . . . how long document 120 is allowed to “live” (i.e., exist, before automatically destroyed by application 130 [on receiving client 101]) . . . .

. . . .

Application 130 [on receiving client 101] is charged with enforcing permissions 121 of the document 120 . . . . It [the actions performed by application 130] may also include destroying document 120 once its allotted “lifetime” expires.

In the first instance, therefore, Botham does not disclose destroying the original document *at the system of the sender*. Rather, Botham discloses destroying the original document *at the system of the recipient* – the receiving client 101. Thus, once a document has been received by the receiving client 101, the document has a “lifetime” at which it is allowed to remain on the receiving client 101. Once this lifetime has expired, the application 130 on the receiving client 101 automatically destroys the document.

Moreover, Botham does not actually destroy the original document *only after* the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document. In the claimed invention, the destruction of the original document at the system of the sender is explicitly tied to the sender’s system having received assurance that the recipient’s system has received transmission of the image of the original document. By comparison, there is no such explicit relationship in Botham. Once the lifetime of the document has expired at the receiving client 101, the document is automatically destroyed, period. It does not matter whether the sender’s system has received assurance that the receiving client 101 has actually received the image of the document – that is, whether the sender’s system has received such assurance is immaterial and irrelevant to the destruction of the document; only whether the lifetime of the document has expired is material and relevant to the destruction of the document. Because such assurance is explicitly related to whether the document is destroyed in claim 1, and because such assurance is completely irrelevant to whether the document is destroyed in Botham, Botham does not teach, disclose, or suggest all the limitations of claim 1.

Applicant has thus explained how Botham in view of Ginter and further in view of Holloway does not teach, disclose, or suggest all the claim limitations of claim 1. Applicant has shown that neither Botham, Ginter, nor Holloway teaches, discloses, or suggests that “the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document,” as to which claim 1 is limited. Insofar as none of these references teach, disclose, or suggest this limitation, it cannot be said that Botham, Ginter, and Holloway in combination teach, disclose, or suggest this limitation. As such, claim 1 is non-obvious and patentable over Botham in view of Ginter and further in view of Holloway.

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicant's representative, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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Date

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